



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,653	12/10/2003	David H. Mikon	DRILL-43700	8854

26252 7590 07/12/2005  
KELLY LOWRY & KELLEY, LLP  
6320 CANOGA AVENUE  
SUITE 1650  
WOODLAND HILLS, CA 91367

EXAMINER

HOWELL, DANIEL W

ART UNIT PAPER NUMBER

3722

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/733,653

Applicant(s)

MIKON ET AL.

Examiner

Daniel W. Howell

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

Art Unit: 3722

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-7, 9, 11-15, 17, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by German 2,413,834. Catcher 10 is considered to be dome shaped and generally hemispheric. The device is considered to be “generally an open-ended cone” as it starts with a smaller diameter and generally flares outward to a larger diameter, as a cone generally would. Note lip 13 and aperture 8. Note from the Abstract that the catcher is transparent. Note thicker portion 9 for reinforcing the opening 8.

3. Claims 1-7, 9, 11-15, 17, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/30147. Collector 11 is transparent and is considered to be both “generally dome-shaped” and “generally hemispheric.” Note metal reinforcement 13 in hole 12. Flange 14 is considered to be a lip.

Art Unit: 3722

4. The use of the trademark QUIK CUTTER™ and ELCO ADJUSTABLE ROUND HOLE CUTTER™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. Claims 1, 4-6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by May (5653561). Figure 4 shows a rubber debris catcher of generally cone shape and having a vacuum port 36. Note lip 34 and aperture 22.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of German '834 or WO '147 in view of May '561. Neither of the German or WO devices show a vacuum attachment. May shows a debris catcher having an outlet 36 for connection to a vacuum for continuous removal of debris. It is considered to have been obvious to have provided either of the German or WO devices with a vacuum conduit as shown by May in order to avoid accidental spillage and prevent the catcher from becoming too full by continuously removing the debris.

Art Unit: 3722

8. Claims 1, 2, 4, 6, 7, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Moore et al (6,830,113). Shroud 2 has a weighted boot/rim 16 for holding the shroud flush against the workpiece and an aperture end 12 for insertion of a tool C. Flexible walls 40, 42, are made of vinyl. Note tube 18 for a vacuum. As seen in figure 1, the device is considered to be generally dome and/or cone shaped.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al '113. While Moore et al states only that the dust catcher is formed of vinyl, it is considered to have been obvious to have experimented with related materials and to have made the device of UVA vinyl acetate in order to provide a wear resistant material that is transparent.

10. Claims 8, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of German '834 or WO '147 in view of Moore et al '113. Neither of the German or WO references disclose UVA vinyl acetate. Moore shows a dust cover made of vinyl. In view of this teaching of Moore et al, it is considered to have been obvious to have experimented with related materials and to have made the devices of German '834 or WO '147 of UVA vinyl acetate in order to provide a wear resistant material that is transparent.

11. While this comment is not a part of any rejection, it is noted that column 3, lines 15+ of Nowick also disclose a vinyl boot 28.

12. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 571-272-4483.

Art Unit: 3722

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. After July 15, 2005, the fax number will change to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell  
Primary Examiner  
Art Unit 3722